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7590

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EXAMINER

TRAN, LOUIS B

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 08/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

**Office Action Summary**

Application No.

09/680,817

Applicant(s)

PONTAN ET AL.

Examiner

Louis B Tran

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/06/02.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This action is in response to applicant's amendment, Paper No. 4, received on June 06, 2002. Applicant's addition of claim 27 in Paper No. 4 is acknowledged.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 10, 14-18, 21, and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Guglielmi (1575263).

With respect to claim 1, Guglielmi discloses a combination flexible planar item and character comprising a flexible item when manipulated takes on the appearance of a character comprising a character body having exterior surface and having at least one character feature generally present on said exterior surface as seen in Figure 1.

With respect to claim 2, Guglielmi discloses a combination flexible planar item wherein flexible item is manipulated by folding as in column 1, line 38.

In reference to claim 3, Guglielmi discloses a combination flexible planar item wherein flexible item is manipulated by rolling as in column 2, line 106.

With respect to claim 4, Guglielmi discloses a combination flexible item wherein flexible planar item is manipulated by folding and rolling as in column 1, line 38 and column 2, line 106.

In reference to claim 5, Guglielmi discloses a planar item wherein at least one character feature is a facial feature as seen in Figure 1.

In reference to claim 6, Guglielmi discloses a planar item and character wherein character feature is an appendage 9 as seen in Figure 1.

In reference to claim 7, Guglielmi discloses a planar item and character wherein character feature is an article of clothing 6 as seen in Figure 1.

In reference to claim 10, Guglielmi discloses a planar item and character wherein at least one character feature is placed onto flexible planar item by sewing means as seen in Figure 1 and described in column 1, line 47.

In reference to claim 14, Guglielmi discloses a planar item and character wherein flexible planar item is generally rectangular shape as seen in Figure 2.

With respect to claim 15, Guglielmi discloses a planar item and character wherein flexible planar item has a plurality of edges wherein at least one edge is fringed and wherein said planar item is manipulated, said fringe forms a characteristic of said character as seen in Figure 2.

With respect to claim 16, Guglielmi discloses a planar item and character wherein the shape of the character is maintained by a belt 11 placed around said body 6 to encircle said body as in as seen in Figure 1.

With respect to claim 17, Guglielmi discloses a planar item and character wherein belt is integral within said planar item as in as seen in Figure 1.

With respect to claim 18, Guglielmi discloses a planar item and character wherein said planar item has a first and second surfaces, first, second, third, and fourth

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edges, a corner connecting said third edge with said second edge and wherein at least one character feature is placed on said first surface, generally proximate to said corner as seen in Figure 2.

With respect to claim 21, Guglielmi discloses a planar item and character wherein at least one character feature is embroidered as seen in Figure 1 and described in column 1, line 47.

In referenced to claim 22, Guglielmi discloses a flexible planar item having at least one character feature present thereon, said flexible planar item being folded and rolled to form a generally cylindrical character body wherein at least a portion of said rolled item forms a portion of the exterior surface of said body, as in column 2, line 96, said body having said character feature oriented generally upon the exterior of said character body as seen in Figure 1.

With respect to claim 23, Guglielmi anticipates the method of providing a flexible planar item having first and second surfaces, and at least first, second, and third edges and at least one character feature placed on said first surface as described in column 1, line 37, manipulating said item to form a character body having said character body, at least a portion of said exterior of said character body formed from said planar item.

With respect to claim 24, Guglielmi anticipates the method step of folding said planar item to form a character body is described in column 1, line 37.

With respect to claim 25, Guglielmi anticipates the method step of rolling said planar item to form a character body is described in column 2, line 96.

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With respect to claim 26, Guglielmi anticipates the step of folding and rolling said planar item to form a character body is disclosed in column 1, line 37 and column 2, line 96.

With respect to claim 27, Guglielmi anticipates a flexible planar item when manipulated, takes on the appearance of a character, said character comprising said planar item manipulated to form a character body, said body having an exterior surface, at least a portion of said exterior surface formed of said planar item, and having at least one character feature generally present on said exterior surface as seen in Figure 1.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8,9,11-13, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guglielmi in view of Mills (4,739,529).

With respect to claim 11, Guglielmi discloses the invention substantially as claimed including the features as discussed above.

Guglielmi does not show a character feature affixed onto said flexible planar item by a snap.

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However, Mills teaches the use of a snap for the purpose of affixing a character feature and retaining a character shape in column 4, line 58 of Mills.

Therefore, it would have been obvious for one having ordinary skill in the art to provide Guglielmi with Mills snaps in order to retain a character shape.

With respect to claims 8, 9, 12, and 13, Guglielmi in view of Mills lacks or does not expressly disclose the use of adhesive (as in claim 8), bonding means (as in claim 9), hook and loop fasteners (as in claim 12), and rivets (as in claim 13).

However, examiner takes official notice that use of adhesive, bonding means, hook and loop fasteners, and rivets is widely practiced in the toy and decorative fields of endeavor, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ these features.

With respect to claims 19 and 20, Guglielmi discloses the invention substantially as claimed including at least one character feature oriented on a surface.

Guglielmi does not explicitly show a planar item constructed and arranged to form said character by being folded in half by orienting a fourth edge over a third edge and a portion of a second surface over itself, to form a folded edge and a half sized planar item folding one third of a half sized item to form a rectangle having two short edges and two long edges.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to show a planar element folded in half by orienting said fourth edge over said third edge and a portion of said second surface over itself, to form a folded edge and a half sized planar item folding one third of said half sized item to form

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a rectangle having two short edges and two long edges since it was known in the art that folding of any manner is widely practiced in conjunction with planar elements.

### **Conclusion**

5. Applicant's remarks have been fully considered but deemed non persuasive.

Applicant contends that the Guglielmi reference does not teach the planar item arranged to form a character body.

In view of Figure 1 and 2 of Guglielmi, there is clearly a planar item arranged to form a character body. The term "forming" is interpreted as :

*verb*

**formed, form-ing, forms** *verb, transitive*

1. a. To give form to; shape: *form clay into figures*. b. To develop in the mind; conceive: *form an opinion*.
2. a. To shape or mold (dough, for example) into a particular form. b. To arrange oneself in: *Holding out his arms, the cheerleader formed a T. The acrobats formed a pyramid*. c. To organize or arrange: *The environmentalists formed their own party*. d. To fashion, train, or develop by instruction or precept: *form a child's mind*.
3. To come to have; develop or acquire: *form a habit*.
4. To constitute or compose a usually basic element, part, or characteristic of.
5. a. To produce (a tense, for example) by assuming an inflection: *form the pluperfect*. b. To make (a word) by derivation or composition.
6. To put in order; arrange.<sup>1</sup>

Clearly, the planar item gives shape and composes the character body.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

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<sup>1</sup> *Th American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.



Applicant contends that the Mills reference does not teach a planar structure forming a portion of the exterior surface of the body but the examiner has not relied on the Mills reference for this specific characteristic.

For the reasons above the grounds of rejection are deemed proper.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

lbt  
August 14, 2002



SCOTT A. SMITH  
PRIMARY EXAMINER